

REMARKS

Claims 1-8, 10-13, and 16-34 are pending. Claims 1, 22, 26, and 30 are amended. The basis for the amendment to claim 1 can be found, for example, at paragraphs 24-26 on page 8 and pending claims 32-34. Claims 22, 26, and 30 are amended to change their dependency from previously canceled claim 14 to claim 1. No claims are added or canceled.

Rejection Under 35 U.S.C. § 112, Second Paragraph

Claims 1-8, 10-13, and 16-34 are rejected under 35 U.S.C. 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter. In particular, the Office alleges that the terms "including" or "include" imply other unspecified material are also *required* by the claims (see Office Action at page 2, emphasis added). Applicants submit that the Action has misconstrued the term "include" which is a transitional term synonymous with "comprising" and is open-ended and covers what is expressly recited along with unrecited subject matter (*see* MPEP 2111.03: "The transitional term 'comprising', which is synonymous with 'including,' 'containing,' or 'characterized by,' is inclusive or open-ended and does not exclude additional, unrecited elements or method steps"). *See also*, MPEP 2163 II ("The transitional term 'comprising' (and other comparable terms, e.g., 'containing,' and 'including') is 'open-ended' - it covers the expressly recited subject matter, alone or in combination with unrecited subject matter"). As such, there is no requirement to specify any other materials in view of Applicants' use of "include" or "including." Withdrawal of the rejection is respectfully requested.

Rejection under 37 CFR 1.75(c)

Claims 18, 26, 32-34 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Specifically, the Action states that claims 18 and 26 define "adhesion-intensifying additive" to be things other than those of claim 1 (see Office Action at page 3). Applicants submit that the "adhesion-intensifying additive" of claims 18 and 26 fall within the scope of claim 1. To the extent the Office may maintain such a rejection in a subsequent Action, Applicants

request that the rejection be supported with a more specific allegation regarding the subject matter alleged to broaden claim 1 so that Applicants may properly address the rejection.

Concerning claims 32-34, the Action also does not specify any particular aspect of claim 1 that is broadened by claims 32-34. Applicants submit that the claims are in proper dependent form, and further limit claim 1 by requiring a component that is optional in claim 1. Withdrawal of the rejection is specifically requested.

Rejections Under 35 U.S.C. § 103(a)

Claims 1-8, 10-34 were rejected under 35 U.S.C. § 103(a) as allegedly obvious over U.S. Patent No. 5,994,493 (“the Krebs patent”). To establish a *prima facie* case of obviousness, there must be some reason, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. *KSR International Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007). Moreover, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The reason to make the claimed combination, and a reasonable expectation of success, must be found elsewhere than in Applicants disclosure, such as in the prior art, the nature of the problem to be solved, or in the knowledge/understanding of the person of ordinary skill in the art. MPEP § 2143; *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Applicants submit that the instant rejection does not meet these requirements.

The Krebs patent concerns a polyurethane composition based on (i) polyether polyols and/or polyester polyols and (ii) aromatic diols. *See*, for example, the Abstract and column 4, lines 23-39. The Office asserts that Applicants’ recitation of “at least one compound” does not exclude the polyethers from being initiated by the aromatic polyol of the Krebs patent (see Office Action at page 12). Although not necessarily agreeing with this assertion, Applicants submit that the presently amended claims do, in fact, exclude the aromatic diol component of the Krebs patent. The instant claims concern the reaction product of (a) diphenylmethane diisocyanate, including at least 95 wt.% of 2,4'-diphenylmethane diisocyanate; and (b) at least one compound selected from the group consisting of polyether-polyols having number average molecular weights less than 1,000, polyalkylene diols having number average molecular weights less than 1,000, and polyester-polyols which are

crystalline, partly crystalline or vitreously amorphous. The components recited in the “wherein” clauses of claim 1 exclude the presence of aromatic diols from the polyester polyol or polyether polyol constructs. The polyalkylene diols construct would also not contain aromatic diols. Nothing in the cited art teaches or suggests preparation of a polyurethane composition without the aromatic diol component. Thus, there is no teaching or suggestion of the composition of the instant claims. Withdrawal of the rejection is respectfully requested.

Rejections Under 35 U.S.C. § 102(b)

Claims 1-8, 10-22, 24-25, 27-31, and 34 were rejected as allegedly anticipated under 35 U.S.C. § 102(b) as allegedly anticipated by the Krebs patent. This patent does not teach a composition lacking an aromatic diol component as discussed above. Therefore, for at least this reason, the instant claims are not anticipated by the Krebs patent.

Alleged Obviousness-Type Double Patenting

Claims 1-8, 10-13, 16-22, 24, 25, 27-31, and 34 were rejected on the ground of alleged nonstatutory obvious-type double patenting over claims 1-29 of the U.S. Patent No. 5,994,493 (“the Krebs patent”). Although Applicants do not agree with the rejection, deferral of the rejection is requested pending the identification of allowable subject matter so that Applicants may address such a rejection in view of the relevant claims.

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Conclusion

Applicants believe that the foregoing constitutes a complete and full response to the Office Action of record. Accordingly, an early and favorable reconsideration of the rejections and an allowance of all of pending claims is earnestly solicited.

Respectfully submitted,

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